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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,173	11/12/2003	Amit Shachak	1005-4-01 USP	6121

				EXAMINER
42698	7590	11/01/2006		FIGUEROA, MARISOL

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ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/706,173	SHACHAK, AMIT
	Examiner	Art Unit	
	Marisol Figueroa	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 September 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-3,7-13 and 17-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-3,7-13 and 17-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>12 November 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20061023

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37

CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for

continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely

paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 9/20/2006 has been entered.

Response to Arguments

2.   Applicant's arguments with respect to claims 1, and 11 have been fully considered but they

are not persuasive.

The Applicant argues that Okkonen fails to determine if the configuration data stored in the

mobile device has been modified by a user, by comparing new configuration data with old

configuration data, and instead, the disclosed system is solely dedicated to detecting the physical

change of a SIM card in a mobile communication device (page 6,lines 11-14).

The Examiner respectfully disagrees. On paragraphs 56-59 of Okkonen, clearly states that

the SIM card change is determined by comparing SIM card information read from the currently

available SIM card (i.e., new configuration data) with SIM card information stored in non-volatile

memory of the electronic device (i.e., old configuration) and reports the changes in SIM card

information, when detected. This is not just a detection of a physical change of a SIM card.

Also, the Applicant argues that once a change of the SIM card is detected, the data reported

to the service coordinator is fixed and permanent since it includes the hardware configuration of the

electronic device (page 6, lines 16-18).

The Examiner respectfully disagrees. On paragraph 38 of Okkonen discloses that the hardware, software, and firmware information of the electronic device can be reported in conjunction with reports of change in SIM card information. This hardware information is optional.

3.   In response to Applicant arguments that Okkonen teaches away from the recited elements in claims 1 and 11 (page 6, line 23 – page 8 lines 1-14). "Arguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under section 102." See MPEP § 2131.05.

4.   With respect to claims 3 and 13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to combine Okkonen with Roth because both references are directed to detecting a change in information stored in a mobile device and transmitting the changes to a remote server.

5.   Applicant's arguments with respect to claims 7-10 and 17-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or

with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by
the inventor of carrying out his invention.

7.   **Claims 1 and 11** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which it is

most nearly connected, to make and/or use the invention.

Claims 1 and 11 recites the limitations of "wherein the updating of the respective records of

the database comprises: comparing the configuration data with the respective records of the

database; transmitting the configuration data to the server system, when it is determined that the

configuration data is different from that stored in the respective records of the databases". The

Examiner cannot find where in the disclosure/specification and drawings the configuration data is

compared with the respective records of the database. On figure 2 and page 11, paragraphs 47-48 of

the specification, the application software determine whether the new configuration data is different

from the old configuration stored in the mobile device memory, and if so, the application software

causes the mobile device to communicate the change to a server system in order to update database

records. However, there is no disclosure of the step of comparing the new configuration with the

respective records of the database in the mobile communication network. Without those additional

details one of ordinary skill in the art would have been burdened by undo experimentation to make

or use the claimed invention. The Examiner interprets by the limitations recited earlier, that the

second comparing step is the same as the first comparing step. The claims will be treated in this

context.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in
the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent
by another filed in the United States before the invention by the applicant for patent, except that an international
application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an
application filed in the United States only if the international application designated the United States and was
published under Article 21(2) of such treaty in the English language.

9.   **Claims 1, 2, 11, and 12** are rejected under 35 U.S.C. 102(e) as being anticipated by

OKKONEN et al. (US 2004/0166839 A1).

Regarding claim 1, Okkonen discloses a method of updating database records associated

with configuration data stored in at least one mobile device in a mobile communication network, the

method comprising:

determining whether the configuration data stored in a mobile device has been modified by a

user of the mobile device by comparing new configuration data with old configuration data (p.0036,

lines 7-12; p.0040; p.0038; p.0056-0057; an agent in the electronic device determines when a SIM

card is being changed, i.e. modification in configuration data, and detects the change by comparing

the SIM card information read from the currently available SIM card (i.e., new configuration) to SIM

card information stored in non-volatile memory of the electronic device (i.e., old configuration)),

wherein the configuration data is used by a processor of the mobile device to identify, process or

route communication signals between the mobile device and one or more communication stations in

the mobile communication network (p.0056, lines 7-11; the SIM card stores data such as an end-

user's unique identity and user's account number with a carrier network, which is notoriously well

known that allows wireless communication with the carrier the user has an account with); and

transmitting the configuration data to a server system for updating respective records of a database in the mobile communication network, in response to the configuration data being modified in the mobile device (p.0037-0038; p.0039, lines 1-6; p.0048, lines 1-5; p.0049; the agent of the electronic device reports the changes of information contained in the SIM card to a service coordinator, i.e. server system, which saves the changes, to information contained in the SIM card, in its database and the database is updated), wherein the updating of the respective records of the database comprises:

comparing the configuration data with the respective records of the database (p.0057; the current SIM card information is compared with information stored on the portable device and therefore, also stored in the service coordinator database); transmitting the configuration data to the server system, when it is determined that the configuration data is different from that stored in the respective records of the databases (p.0059, lines 1-4; the SIM card change information is communicated to the service coordinator when it is determined that the SIM card has changed) and replacing at least one record in the database based on the modified configuration data (p.0039, lines 1-6; p.0049, lines 1-7),

such that a customer service agent can access the database records to determine the mobile device's configuration for trouble shooting purposes (p.0060, lines 14-16; the system has the capability to be used for trouble shooting purposes, furthermore, the language used by the applicant merely suggests or makes optional those features described as "statements of intended use" (i.e., "such that", "for trouble shooting purposes"; such language does not require the steps to be performed or does not limit the scope of a claim limitation, MPEP § 2106 (c), 2111.04).

Regarding claim 2, Okkonen discloses the method of claim 1, further comprising:
transmitting the configuration data to the server in real time (p.0038; the agent reports the changes
of SIM card to the service coordinator as they are detected, i.e. real time).

Regarding claim 11, Okkonen discloses a system for updating database records associated
with configuration data stored in at least one mobile device in a mobile communication network, the
system comprising;

a comparator for determining whether the configuration data stored in the mobile device has
been modified by a user of the mobile device by comparing new configuration data with old
configuration data (p.0036, lines 7-12; p.0040; p.0038; p.0056-0057; an agent in the electronic device
compares SIM card information read from the currently available SIM card (i.e., new configuration)
to SIM card information stored in non-volatile memory of the electronic device (i.e., old
configuration) to detect a change in SIM card information), wherein the configuration data is used
by a processor of the mobile device to identify, process or route communication signals between the
mobile device and one or more communication stations in the mobile communication network
(p.0056, lines 7-11; the SIM card stores data such as an end-user's unique identity and user's account
number with a carrier network, which is notoriously well known that allows wireless communication
with the carrier the user has an account with); and

a transmitter for transmitting the configuration data to a server system in the mobile
communication network for updating respective records of a database, in response to the
configuration data being modified in the mobile device (p.0037-0038; p.0039, lines 1-6; p.0048, lines
1-5; p.0049; the agent of the electronic device reports the changes of information contained in the
SIM card to a service coordinator, i.e. server system, which saves the changes in its database, and

updates the database, furthermore, it is inherent that the portable device includes a transmitter for

reporting or otherwise transmit the SIM card changes to the service coordinator),

wherein the configuration data is directly compared with the respective records of the

database (p.0057; the current SIM card information is compared with information stored on the

portable device and therefore, also stored in the service coordinator database), and at least one

record is updated based on information contained in the configuration data, when it is determined

that the configuration data is different from that stored in the respective records of the databases

(p.0039, lines 1-6; p.0049, lines 1-7).

Regarding claim 12, Okkonen disclose the system of claim 11, wherein the transmitter

transmits the configuration data to the server system in real time (p.0038; the agent reports the

changes of SIM card to the service coordinator as they are detected, i.e. real time).

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
> 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the
> subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

11.   **Claims 3 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over

OKKONEN et al. in view of ROTH et al. (US 2005/0164692 A1).

Regarding claim 3, Okkonen discloses the method of claim 1, but doesn't expressly

disclose transmitting the configuration data to the server system within a predetermined time period,

if it is determined that the configuration data is modified in the mobile device. However, in a related

field of endeavor Roth teaches a method of wirelessly transmitting changes of user-configurable customization by a user of a mobile communication device to a remote server when detecting the user-configurable customization of any of the applications has changed since an earlier time, i.e. the updated database entries are transmitted at a predetermined time (abstract; p.0008, lines 1-18).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to one having ordinary skill in the art, to schedule at a predetermined time the transmission of the configuration data to the server as suggested by Roth, because scheduling of a data transfer to a server would ideally take place during a time period when the user is not using the device so as not to interfere with normal use.

Regarding claim 13, Okkonen discloses the system of claim 11, but doesn't expressly disclose transmitting the configuration data to the server system within a predetermined time period, if it is determined that the configuration data is modified in the mobile device. However, in a related field of endeavor Roth teaches a method of wirelessly transmitting changes of user-configurable customization by a user of a mobile communication device to a remote server when detecting the user-configurable customization of any of the applications has changed since an earlier time, i.e. the updated database entries are transmitted at a predetermined time (abstract; p.0008, lines 1-18).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to one having ordinary skill in the art, to schedule at a predetermined time the transmission of the configuration data to the server as suggested by Roth, because scheduling of a data transfer to a server would ideally take place during a time period when the user is not using the device so as not to interfere with normal use.

12.   **Claims 7, 9, 17, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over OKKONEN et al. in view of CHILDS et al. (US 2002/0107868 A1).

Regarding claims 7 and 9, Okkonen discloses the method of claim 1, but doesn't expressly disclose further comprising: determining whether the configuration data transmitted to the server is invalid and further generating an alert when the configuration is invalid.

However, Childs teaches a method and system for collecting data, e.g. "RAM data", from distributed locations and transmitting the data to a server computer. The data can be collected on periodic basis and the collected data is transmitted to a server computer, and when the server computer receives the data, it validates the data, if valid, automatically stores the data in a database. When the data is <u>invalid</u> the server computer sends an error message (i.e., alert) so that the error can be corrected (p.0018).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention, to determine whether the configuration data (i.e., RAM data) transmitted to the server is invalid and further generating an alert when the configuration data is invalid, as suggested by Childs, in order to correct errors in the data deemed to be invalid and assuring the quality (e.g. validity) of the data that will be stored in the server database.

Regarding claims 17 and 19, Okkonen discloses the system of claim 11, but doesn't expressly disclose further comprising: determining whether the configuration data transmitted to the server is invalid and further generating an alert when the configuration is invalid.

However, Childs teaches a method and system for collecting data, e.g. "RAM data", from distributed locations and transmitting the data to a server computer. The data can be collected on periodic basis and the collected data is transmitted to a server computer, and when the server computer receives the data, it validates the data, if valid, automatically stores the data in a database. When the data is <u>invalid</u> the server computer sends an error message (i.e., alert) so that the error can be corrected (p.0018).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention, to determine whether the configuration data (i.e., RAM data) transmitted to the server is invalid and further generating an alert when the configuration data is invalid, as suggested by Childs, in order to correct errors in the data deemed to be invalid and assuring the quality (e.g. validity) of the data that will be stored in the server database.

13.   **Claims 8, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over OKKONEN et al. in view of CHILDS et al., and further in view of BARTELS et al. (US 2003/0208704 A1).

Regarding claim 8, the combination of Okkonen and Childs disclose the method of claim 7, Childs discloses correcting the configuration data, when the configuration data is invalid (p.0018; also see remarks of claims 7 and 9 above), but doesn't expressly disclose wherein the data can be corrected automatically. However, the automatic correction of invalid data is well known in the art and Bartels is evidence of the fact. Bartels teaches a computer systems that includes an error detector for detecting errors or corruptions in data stored (i.e., invalid) and is capable of automatically correct the errors without user intervention (p.0014; p.0020). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to modify Childs for automatically correcting the invalid data, as suggested by Bartels, in order to correct the invalid data without user intervention, therefore, reducing the time it takes to correct errors in data.

Regarding claim 18, the combination of Okkonen and Childs disclose the system of claim 17, Childs discloses correcting the configuration data, when the configuration data is invalid (p.0018; also see remarks of claims 7 and 9 above), but doesn't expressly disclose wherein the data can be corrected automatically. However, the automatic correction of invalid data is well known in the art and Bartels is evidence of the fact. Bartels teaches a computer systems that includes an error

detector for detecting errors or corruptions in data stored (i.e., invalid) and is capable of

automatically correct the errors without user intervention (p.0014; p.0020). Therefore, it would have

been obvious to a person having ordinary skill in the art at the time of the invention, to modify

Childs for automatically correcting the invalid data, as suggested by Bartels, in order to correct the

invalid data without user intervention, therefore, reducing the time it takes to correct errors in data.

14.   **Claims 10 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over

OKKONEN et al. in view of HILTUNEN et al. (US 2004/0042604 A1).

Regarding claim 10, Okkonen discloses the method of claim 1, but doesn't expressly

disclose wherein the configuration data comprises at least one of an access point name (APN), a

web gateway internet protocol (IP) address, a short messaging service center (SMSC), system

identification code (SID), system dependent information, and communication environment

dependent information.

However, Hiltunen teaches that a SIM card stores information used by the microprocessor

to enable the telephone to communicate on the appropriate network, other data stored may be used

to for example to control, or modify the operation of the mobile telephone. And such information

stored comprises subscriber related data, e.g., subscriber number, <u>system ID</u>, system channel scan

data and serial number (p.0033). Therefore, it would have been obvious to one having ordinary skill

in the art at the time of the invention, to recognize that a SIM card comprises configuration data,

e.g., as system identification, as taught by Hiltunen, because data stored in the SIM card (e.g., system

ID) enables the telephone to communicate on the appropriate network and also to control or

modify the operation of the telephone (p.0033, lines 21-26).

Regarding claim 20, Okkonen discloses the system of claim 11, but doesn't expressly

disclose wherein the configuration data comprises at least one of an access point name (APN), a

web gateway internet protocol (IP) address, a short messaging service center (SMSC), system identification code (SID), system dependent information, and communication environment dependent information.

However, Hiltunen teaches that a SIM card stores information used by the microprocessor to enable the telephone to communicate on the appropriate network, other data stored may be used to for example modify the operation of the mobile telephone. And such information stored comprises subscriber related data, e.g., subscriber number, system ID, system channel scan data and serial number (p.0033). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention, to recognize that a SIM card comprises configuration data, e.g., as system identification, as taught by Hiltunen, because data stored in the SIM card (e.g., system ID) enables the telephone to communicate on the appropriate network and also to control or modify the operation of the telephone (p.0033, lines 21-26).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marisol Figueroa whose telephone number is (571) 272-7840. The examiner can normally be reached on Monday Thru Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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Marisol Figueroa
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